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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,494	08/29/2006	Kazuo Tagawa	07481.0045	5119
22852	7590	08/09/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VASISTH, VISHAL V	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			08/09/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,494

Applicant(s)

TAGAWA ET AL.

Examiner

VISHAL VASISTH

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

1. Applicants' response filed on 6/10/2010 amended independent claims 10, 13 and 16. Applicants' amendments overcome the claim objections and the 35 USC 102 rejections over Kawahara and Corr from the office action mailed on 3/12/2010 and therefore these rejections are withdrawn. Applicants did not file a terminal disclaimer to obviate the double patenting rejection from the office action mailed on 12/15/2008 therefore this rejection is maintained below and incorporated herein by reference. A new ground of rejection necessitated by the amendment is set forth below.

Information Disclosure Statement

2. The information disclosure statements filed on 6/9/2010 and 7/15/2010 fail to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 FR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

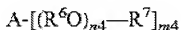
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yokota et al., US Patent No. 7,595,286 (hereinafter referred to as Yokota). The examiner notes that this is the US national phase application (therefore in English) of WIPO application No. WO02/081605 which is in Japanese and has a 102(b) date.

Yokota discloses an oil composition comprising an ester base oil such as a full ester of a polyhydric alcohol such as glycerol and a monobasic acid such as straight-chain or branched hexanoic acid (as recited in claims 10 and 12-13) (Col. 6/L. 6-39 and Col. 4/L. 14-60).

Yokota further discloses additives including more preferably 0.1 to less than 10 wt% of an oiliness improver including an ester of a monohydric alcohol such as methanol and a monobasic acid such as a straight-chain pentadecanoic acid (as recited in claims 10-11) (Col. 3-4/L. 52-67 and Col. 16/L. 25-44 and Col. 17/L. 6-15).

Yokota also discloses oxygen-containing compounds having the following formula:



wherein A is a residue resulting from the removal of all or some of the hydrogen atoms of the hydroxyl groups of a polyhydric alcohol having 3 to 10 hydroxyl groups such as glycerol, R^6 is an alkylene group having 2 to 4 carbon atoms, R^7 is a hydrogen atom or a hydrocarbon group having 1 to 30 carbon atoms, n^4 is an integer selected so as to provide the number-average molecular weight of from 100 to 3,500, and m^4 indicates

the same number as that of the removed hydrogen atoms from the hydroxyl groups of A (as recited in claim 13) (Col. 15/L. 42-67).

Finally Yokota discloses additional additives that can be added to formulate a finished lubricant composition including phosphite ester and phosphorothionates (as recited in claims 10 and 13-18) (Col. 12/L. 11-37) and diethylene glycol monoalkylether (as recited in claim 16) (Col. 17/L. 21).

It is the position of the examiner that although Yokota does not disclose the composition being used in a refrigerating oil composition, that since Yokota discloses all of the limitations of the instant claims that the composition can inherently function in a refrigerating oil composition. Furthermore, the preamble of a claim is generally not afforded any patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 10-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/565,739. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The rejection from paragraph 11 of the office action mailed on 12/15/2008 is incorporated herein by reference.

Response to Arguments

7. Applicants' arguments filed on 6/10/2010 with respect to claims 10-18 have been fully considered and are moot in light of the new grounds of rejection set forth above.

It is the position of the examiner that the double patenting rejection is maintained because although the copending application does not recite the ester additive of claim 10 or the oxygen-containing compound of claims 13 and 16, these additives are very well known in the art and are obvious in light of the disclosure of Yokota discussed above.

Conclusion

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **VISHAL VASISTH** whose telephone number is (571)270-3716. The examiner can normally be reached on **M-R 8:30a-5:30p**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797